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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,550	01/28/2004	David Robison	CRS / 278	3112
26875 7590 11/01/2007 WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			EXAMINER A, PHI DIEU TRAN	
			ART UNIT 3633	PAPER NUMBER
			MAIL DATE 11/01/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/766,550

**Applicant(s)**

ROBISON ET AL.

**Examiner**

Phi D. A

**Art Unit**

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-2, 4, 6-7, 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are to a method of rolling a membrane; the claims, however, include the step of “transporting said roll of sheeting to a job site...membrane sheet”, “repeating the above to form a plurality of rolls” which is inconsistent with “rolling a membrane”. The step of “transporting...membrane sheet” and the step of “repeating the above to form a plurality of rolls” is not related to the steps of rolling a membrane sheeting. The claims are thus indefinite as they are confusing in scope.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 6, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeuwenburgh (5935669) in view of Chiu (4855172).

Leeuwenburgh shows a method of rolling a membrane sheeting having a seam tape (16) applied only along a first edge of the membrane sheeting with a portion of the membrane

sheeting having no seam tap, the portion (14) extending from the seam tape to a second edge, the membrane having a thickness greater than or equal to a thickness of the seam tape (col 1 lines 61-63 states that the combined thickness of the tape and cover strip being at least about equal to the total thickness of all folding layers, and col 1 lines 6-8 discloses the covering sheet being folded at least two folding layers (2 layers included), and as the cover being two layers and having thickness equal to the combined thickness of the tape and the cover strip, it goes that the cover strip and the tape are of equal thickness in this embodiment, and applicant also discloses using varying thickness for the tape/covering strip), comprising folding the portion of the membrane sheeting over upon itself only once (for the embodiment when there are only two folding layers, each layer being the top or the bottom layer) to form a folded sheet wherein the portion of sheeting does not overlie any area of the membrane sheeting having seam tape adhered thereto (figures 1, 3), rolling the membrane sheeting (col 2 lines 30-34), the seam tape is on a first surface of the membrane sheeting and the portion of the membrane sheeting is folded onto the first surface (col 2-3, lines 65-2 discloses the different possible location of the fold and the tape), the sheeting having a first edge and a second edge, the portion of the membrane is folded toward the first edge with the second edge of the sheeting resting adjacent the seam tap (figure 3),

Leeuwenburgh does not show the step of transporting the roll of sheeting to a job site, unrolling the membrane sheeting and adhering the seam tape to an edge of an adjacent membrane sheet, repeating the above to form a plurality of rolls, and stacking the rolls on themselves.

Chiu discloses the step of transporting a membrane (18) to a job site (roof) to be attached to another membrane (17) to provide for a weather barrier for a structure at the site.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Leeuwenburgh's method steps to show the step of transporting the roll of sheeting to a job site, unrolling the membrane sheeting and adhering the seam tape to an edge of an adjacent membrane sheet, repeating the above to form a plurality of rolls, and stacking the rolls on themselves because transporting the roll to a job site and unrolling the sheeting and adhering the seam tape to an edge of an adjacent sheet would allow for the relocation of the membrane to the job site to be overlapped with other membranes forming a covering weather barrier as taught by Chiu, and modifying Leeuwenburgh's method steps to show the steps of repeating the above to form a plurality of rolls, and stacking the rolls on themselves would have been obvious to one having ordinary skill in the art as the steps allow for the formation of extra rolls and positioning the rolls neatly and compactly for easy transporting.

Per claim 9, Leeuwenburg as modified further shows the job site being a roof per Chiu's teaching.

3. Claim 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeuwenburgh (5935669) in view of Chiu (4855172).

Leeuwenburgh as modified shows all the claimed limitation except for the membrane sheeting being EPDM.

Chiu further discloses the weather barrier membrane being EPDM or neoprene.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Leeuwenburgh's modified structure to show the membrane sheeting being

EPDM because EPDM and neoprene are well known plastic material for forming weather barrier on a roof as taught by Chiu.

4. Claim 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeuwenburgh (5935669) in view of Chiu (4855172) as applied to claim 1 above and further in view of Cox et al.

Leeuwenburgh as modified shows all the claimed limitation except for the membrane sheeting being EPDM.

Cox et al discloses backing sheeting being made of a variety of plastics including EPDM (col 6 lines 47-62).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Leeuwenburgh's modified structure to show the membrane sheeting being EPDM because it would provide a balance between compliance and clean removal as taught by Cox et al.

5. Claim 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeuwenburgh (5935669) in view of Chiu (4855172).

Leeuwenburgh shows a roll of membrane sheeting having a first edge and a second edge, a seam tape adhered only the first edge wherein the second edge is folded toward the first edge and wherein the second edge does not overlie said seam tape.

Leeuwenburg does not show the sheeting being selected form the group consisting of EPDM, thermoplastic elastomer, butyl rubber, and PVC and having a thickness of 30-100 mils and said seam tape is thinner than the sheeting, a plurality of rolls of membrane sheeting stacked upon themselves.

Chiu discloses a weather barrier sheeting being of EPDM, the seam tape (col 11 lines 20-50) having a thickness of 30-100 mils, the seam tape being thinner than the sheeting.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Leeuwenburg's structure to show sheeting being selected from the group consisting of EPDM, thermoplastic elastomer, butyl rubber, and PVC and having a thickness of 30-100 mils and said seam tape is thinner than the sheeting because it would enable the formation of a sheeting that can be easily overlapped and secured to other sheetings to form a covering membrane as taught by Chiu, and having a plurality of rolls of membrane sheeting stacked upon themselves would allow for the neat, and compact transport of the rolls.

1. Claims 1, 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuoriniemi (6444307) in view of Kreckel (5747131) and Chiu.

Tuoriniemi (figure 5b) shows a method of rolling a membrane sheeting having a seam adhesive (22b) applied only along a first edge of the membrane sheeting with a portion of the membrane sheeting having no seam tap, the portion (14) extending from the seam adhesive to a second edge, the membrane (20) having a thickness greater than or equal to a thickness of the seam adhesive, comprising folding the portion of the membrane sheeting over upon itself only once to form a folded sheet wherein the portion of sheeting does not overlie any area of the membrane sheeting having seam adhesive adhered thereto (figure 5b), rolling the membrane sheeting (figure 6a), the seam adhesive is on a first surface of the membrane sheeting and the portion of the membrane sheeting is folded onto a second surface of the membrane sheeting, the membrane sheeting is EPDM (col 7 line 39), the roll of membrane having the second edge being folded toward the first edge and wherein the second edge does not overlie the seam adhesive, the

portion of the membrane is folded toward the first edge with the second edge of the sheeting resting adjacent (closely next to) to the seam adhesive, the seam adhesive does not extend beyond the first edge of the membrane sheeting, transporting the roll of sheeting to a job site, unrolling the membrane sheeting (inherently so as the roll of covering has to arrive at the job site/wherever that might be, and unroll to attach to doors, windows which have planar sheet).

Tuoriniemi does not show the seam adhesive being seam tape, adhering the seam adhesive to an edge of an adjacent membrane sheet, repeating the above to form a plurality of rolls, stacking the plurality of rolls on themselves.

Chiu discloses membrane (17, 18) overlapping to form a barrier.

Kreckel discloses a double side adhesive seam tape (2) attaching to a membrane (1) to enable the easy attachment of the membrane to another structure.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Tuoriniemi's structure to show the seam adhesive being seam tape because a double sided adhesive seam tape would provide for good adhering of the inside of the covering to a window surface while leaving the outer surface to properly cover the protected area as taught by Kreckel; furthermore, examiner takes Official Notice of the well known equivalence of using a strip of adhesive or a double sided tape to form an adhesive means for a covering structure as they both function the same to provide a means for bonding the covering structure to another surface, and having the membranes overlapping with adhesive therebetween would enable the formation of a membrane able to cover a large area as taught by Chiu, having the steps repeated to form a plurality of rolls would have been obvious to one having ordinary skill in the art as it



enables the manufacturer to produce more rolls, and stacking the rolls on themselves allows for the neat, and compact transport/storage of the rolls.

2. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuoriniemi (6444307) in view of Kreckel (5747131) and Chiu.

Tuoriniemi (figure 11f) shows a method of rolling a membrane sheeting having a seam adhesive (22b) applied only along a first edge of the membrane sheeting with a portion of the membrane sheeting having no seam tap, the portion (30) extending from the seam adhesive to a second edge, the membrane (30) having a thickness greater than or equal to a thickness of the seam adhesive, comprising folding the portion of the membrane sheeting over upon itself only once to form a folded sheet wherein the portion of sheeting does not overlies any area of the membrane sheeting having seam adhesive adhered thereto (figure 11f), rolling the membrane sheeting (figure 6a), the seam adhesive is on a first surface of the membrane sheeting and the portion of the membrane sheeting is folded onto a first surface of the membrane sheeting (the folding of part 30 per the folding at 50b onto the first surface touched by adhesive 22b).

Tuoriniemi does not show the seam adhesive being seam tape, adhering the seam tape to an edge of an adjacent membrane sheet, repeating the above to form a plurality of rolls, stacking the plurality of rolls on themselves.

Chiu discloses the adhering of the seam tape to an edge of an adjacent membrane sheet.

Kreckel discloses a double side adhesive seam tape (2) attaching to a membrane (1) to enable the easy attachment of the membrane to another structure.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Tuoriniemi's structure to show the seam adhesive being seam tape because a

double sided adhesive seam tape would provide for good adhering of the inside of the covering to a window surface while leaving the outer surface to properly cover the protected area as taught by Kreckel; furthermore, examiner takes Official Notice of the well known equivalence of using a strip of adhesive or a double sided tape to form an adhesive means for a covering structure as they both function the same to provide a means for bonding the covering structure to another surface, and adhering the seam tape to an edge of an adjacent membrane sheet would allow for the formation of a membrane able to cover a large area as taught by Chiu, having the steps repeated to form a plurality of rolls would have been obvious to one having ordinary skill in the art as it enables the manufacturer to produce more rolls, and stacking the rolls on themselves allows for the neat, and compact transport/storage of the rolls.

6. Claims 1, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeuwenburgh (5935669) in view of Enns (5713085) and Chiu.

Leeuwenburgh shows a method of rolling a membrane sheeting having a seam tape (16) applied only along a first edge of the membrane sheeting with a portion of the membrane sheeting having no seam tap, the portion (14) extending from the seam tape to a second edge, the membrane having a thickness greater than or equal to a thickness of the seam tape (col 1 lines 61-63 states that the combined thickness of the tape and cover strip being at least about equal to the total thickness of all folding layers, and col 1 lines 6-8 discloses the covering sheet being folded at least two folding layers (2 layers included), and as the cover being two layers and having thickness equal to the combined thickness of the tape and the cover strip, it goes that the cover strip and the tape are of equal thickness in this embodiment, and applicant also discloses using varying thickness for the tape/covering strip), comprising folding the portion of the

membrane sheeting over upon itself only once (for the embodiment when there are only two folding layers, each layer being the top or the bottom layer) to form a folded sheet wherein the portion of sheeting does not overlies any area of the membrane sheeting having seam tape adhered thereto (figures 1, 3), rolling the membrane sheeting (col 2 lines 30-34).

Leeuwenburgh does not show the step of transporting the roll of sheeting to a job site, unrolling the membrane sheeting and adhering the seam tape to an edge of an adjacent membrane sheet, the job site being a pond, the step of repeating the above to form a plurality of rolls, stacking the rolls on themselves.

Enns discloses the use of a membrane at a job site, the job site being a pond to enable the formation of a waterproof barrier for the pond.

Chiu discloses the step of attaching a membrane to another membrane (17) at a job site to provide for a weather barrier for a structure at the site.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Leeuwenburgh's method steps to show the step of transporting the roll of sheeting to a job site, unrolling the membrane sheeting and adhering the seam tape to an edge of an adjacent membrane sheet as taught by Chiu because it would allow for the relocation of the membrane to the job site to be overlapped with other membranes forming a covering weather barrier as taught by Chiu, and having the job site being a pond would enable the formation of a waterproof pond with a membrane as taught by Enns, and modifying Leeuwenburgh's method steps to show the steps of repeating the above to form a plurality of rolls, and stacking the rolls on themselves would have been obvious to one having ordinary skill in the art as the steps allow

for the formation of extra rolls and positioning the rolls neatly and compactly for easy transporting.

***Response to Arguments***

7. Applicant's arguments filed 8/20/07 have been fully considered but they are not persuasive.
8. Applicant states that the steps of transporting and unrolling are all part of the invention, and thus are not indefinite, examiner respectfully points out that the preamble is to the steps of rolling a membrane sheeting. the step of transporting has nothing to do with rolling a membrane. it thus confuses the scope of the claim, and is thus indefinite. The newly added step of stacking the rolls on themselves, has the same problem as the step of transporting.
9. With respect to applicant's statements on how Leeuwenburg reference is different as it has different weights and sizes, the argument is moot as they are not claimed limitations.
10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).
11. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

12. With respect to the Declaration of David Robsion, the declaration has been considered and found not persuasive. First of all, the size/weight of the product is not claimed. secondly, the method of stacking the tapes are not claimed. As the declaration is not commensurate with the scope of the claims, the declaration is hereby found not persuasive.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phi Dieu Tran A

PA

10/29/07

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